

### **AMENDMENTS TO THE DRAWINGS**

The attached sheets of drawings include changes to Figures 1-3 and 7.

Sheet 1, which includes Figure 1, replaces the original sheet 1, including Figure

1. In Figure 1, previously omitted -- Prior Art-- has been added.

Sheet 2, which includes Figures 2 and 3, replaces the original sheet 2, including Figures 2 and 3. In Figures 2 and 3, previously omitted -- Prior Art-- has been added.

Sheet 4, which includes Figure 7, replaces the original sheet 4, including Figure

7. In Figure 7, previously omitted -- Prior Art-- has been added.

Attachment: Replacement Sheets 1-2 and 4

Annotated Sheets 1-2 and 4 Showing Changes

### **ELECTION AND REMARKS**

In response to the Restriction Requirement mailed November 10, 2003, Applicant respectfully elects the invention of Group I, drawn to claims 1-8 and 17. The election is made without traverse. Claims 9-16 have been cancelled, without prejudice to Applicant's right to file divisional or continuation applications to cover the cancelled subject matter.

Claims 1-2, 4-8, and 17, appear in this application for the Examiner's review and consideration.

In amended Figures 1-3, and 7, the previously omitted reference to -- Prior Art -- has been added.

Claim 1 has been amended to recite the limitations of claim 3.

Claims 4-8, have been amended to recite proper dependency and antecedent basis.

Claim 8 has been amended to recite proper antecedent basis for "basket".

Claims 3, and 9-16 have been cancelled without prejudice to Applicants' right to file one or more continuing applications directed to any subject matter not presently claimed.

No new matter has been added by these amendments and additions.

### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reason of insufficient antecedent basis for "the basket". This has been corrected.

The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicant respectfully request reconsideration and withdrawal thereof.

### **Rejection Over U.S. Patent No. 4,613,403**

Claims 1-2, and 7, were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,613,403 to Oyachi *et al.*

For claims to be rejected under 35 U.S.C. § 102(b), each and every element as set forth in the claims of the present invention must be found, either expressively or inherently, in a single prior art reference. Applicant respectfully submits that Oyachi does not disclose all the elements of the claimed invention.

The present invention is directed to an improvement in a rotating tumbler for holding golf balls during treatment with glow discharge plasma of high intensity. The improvement is directed towards providing a curved radius that is machined about the outer ridges of a plurality of holes, which are arranged in a staggered pattern, so that an anodic coating may easily be applied at these locations and thereby removing any sharp edges that may mark or defect the golf balls. The size and design of the holes should be large enough to provide quick evacuation with minimal resistance, but not so large that they will allow the golf balls to nestle within them.

Oyachi teaches an apparatus for holding golf balls and exposing them to unpolymerizable gas plasma. Oyachi does not disclose a rotating tumbler as made by the Applicant, which provides a plurality of holes in a staggered pattern, wherein each hole has a curved radius machined about the outer ridges so that an anodic coating may be easily applied.

Accordingly, independent claim 1 is believed to be in condition for allowance for at least the reasons set forth above. Moreover, the remaining claims 2 and 7 depend from the claim discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

**Rejection Over Oyachi et al. In View of U.S. Patent No. 5,591,268**

Claim 3 was rejected under 35 U.S.C. § 103(a) as being obvious over Oyachi et al. in view of U.S. Patent No. 5,591,268 to Usui *et al.* Although claim 3 has now been cancelled, it has been combined with claim 1, and the present rejection would now be directed to the currently amended claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Usui et al. fails to cure the deficiencies of Oyachi et al. Neither reference, alone or in combination, discloses the creation of a plurality of holes having a curved radius in the outer ridges of the holes, as now recited in claim 1 of the present invention. The Examiner stated that Usui et al. teaches the curved radius, but the Applicant respectfully must disagree. Usei et al. does not disclose this feature, and holes having sharp edges are far more difficult to anodize, and the anodizing erodes from the sharp edge relatively easy.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicant respectfully requests reconsideration and withdrawal thereof.

Claims 4-6 and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over Oyachi et al. in view of U.S. Patent No. 5,591,268 to Usui *et al.* The Examiner has stated that the Applicant's claim of dimensions and radii would not present an apparatus that would perform differently than that of the prior art. The Applicant must again respectfully disagree with the Examiner. The reason for the Applicant's invention was specifically to increase the quality of the golf ball product. With the employment of apparatus like that of Oyachi et al. and Usui et al., the amount of rejects of finished golf balls is higher, because of the sharp edges which allow for any anodizing to quickly erode. The curved radii of the present invention and the specific hole size and pattern improved ball quality. Therefore, the apparatus of the present invention performed much differently than that of the references.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicant respectfully requests reconsideration and withdrawal thereof.

**Rejection Over Oyachi et al. In View of U.S. Patent No. 5,895,586**

Claim 8 was rejected under 35 U.S.C. § 103(a) as being obvious over Oyachi et al. in view of U.S. Patent No. 5,895,586 to Kaji *et al.*

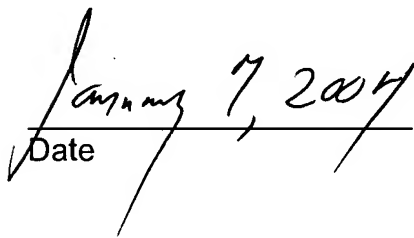
Claim 8 adds additional features and is dependent on independent claim 1, which has been argued above to be in condition for allowance

Accordingly, this claim is believed to be patentable for the totality of the claimed invention therein and by virtue of its dependence from the independent claim. As such, Applicant respectfully requests reconsideration and withdrawal thereof


**Conclusion**

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant's agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

No fee is believed to be due for this submission. However, should a fee or any other required fees be due, please charge them to the Acushnet Company Deposit Account No. 502309.

  
Date

Respectfully submitted,

  
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Attachments-Replacement Sheets  
Annotated Sheets